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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,734

02/21/2006

Pernille Baardseth

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BACON & THOMAS, PLLC

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ALEXANDRIA, VA 22314-1176

EXAMINER

INYARD, APRIL C

ART UNIT

PAPER NUMBER

4152

MAIL DATE

DELIVERY MODE

10/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/528,734	<b>Applicant(s)</b> BAARDSETH ET AL.	
	<b>Examiner</b> APRIL C. INYARD	<b>Art Unit</b> 4152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/23/05</u> .                                                | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### *Claim Objections*

1. Claims 5 and 6 are objected to because of the following informalities: It is unclear as to what the terminology “ready to cook” means as a limitation within the instant claims includes cooking the potato product by frying. The Examiner interprets the terminology of the instant claims to mean a process for the preparation of French fried potatoes. Additionally, the word "which" is interpreted to be "wherein". Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 5 and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hilton et al. (US Patent No. 4,140,801) as evidenced by Porro et al. (US Patent No. 6,429,006 B1).**

Hilton ('801) discloses a process for the preparation of a potato product wherein the process comprises chopping the raw potato ('801, Col 2, lines 57-60) followed by fermentation with a microorganism that is “sufficient to lower the reducing sugar content of the potato solids during fermentation to an extent that they have improved resistance to browning during frying” ('801, yeast, Col 3, lines 39-43). Hilton further teaches that the potato product may be "french cut" ('801, Col 5, line 50).

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While Hilton ('801) teaches the use of yeast, the reference does not expressly teach the presence of lactic acid in the fermentation process, but note that Porro et al. ('006), does teach that yeast can produce lactic acid ('006, *Abstract*). Thus, it follows that the yeast of Hilton necessarily and inherently produces lactic acid during the fermentation process.

4. **Claims 6 and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by Gertz et al. (*Eur. J. Lipi Sci. Technol.* 104(2002): 762-771).**

Gertz et al. teaches a process for the preparation of french fried potatoes, involving addition of a physiologically acceptable acid to chopped potatoes and frying the acid treated potatoes. Note here, that the Examiner interprets the term “physiologically acceptable acid” as acids known in the art used in the preparation of foodstuffs as defined in the Applicant’s specification in paragraphs [0009] and [0010]. The acid taught by Gertz is an “additive, which optimized the heat transfer from oil to product and pH...consists of citric acid” and further explains that addition of an acid additive significantly reduces the formation of acrylamide in the french fried potato (*page 770, Fig. 10; citric acid, Col 2, lines 1-12*). It therefore follows that the citric acid taught by Gertz is an acid naturally occurring in citrus fruits (e.g. oranges) and is thus a physiologically acceptable acid added to chopped potatoes that are subsequently fried.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaaber et al. (*Potato Research* 38(1995): 39-45).**

Kaaber discloses a process for the preparation of a fried potato product, e.g. chip, wherein the potatoes are chopped and fermented with a lactic acid producing microorganism and then fried (*Kaaber, page 40, Materials and Methods, bacterial inoculum and fermentation, lactobacillus*).

Kaaber discloses the claimed invention except for specifically cutting the potatoes into the shape of a French fry. It would have been obvious to one having ordinary skill in the art at the time the invention was made to cut the potatoes into a French fry shape instead of a “chip”, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *Gardner v. TEC Systsems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 569 U.S. 830, 225 USPQ 232 (1984). It has been held that where the claimed and prior art products are identical or substantially identical in structure or are produced by identical or a

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substantially identical processes, a *prima facie* case of either anticipation or obviousness will be considered to have been established over functional limitations that stem from the claimed structure. *In re Best*, 195 USPQ 430, 433 (CCPA 1977), *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). The *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed products. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Xu et al. (WO 01/78521 A2) teach fried potato products wherein the potatoes are fermented with a microorganism prior to frying.
- b. Green et al. (US Patent No. 3,891,771) teaches fermentation of vegetable products.
- c. Baldwin (US Patent No. 2,744,017) teaches the fermentation of potatoes in lactic acid producing bacteria.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL C. INYARD whose telephone number is (571) 270-1245. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:00 PM EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Del Sole can be reached on (571) 272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/APRIL C INYARD/  
Examiner, Art Unit 4152

/Joseph S. Del Sole/  
Supervisory Patent Examiner, Art Unit 4152